

## **REMARKS**

Reconsideration of this application and withdrawal of the rejections set forth in the Office Action mailed February 12, 2007, is requested in view of the amendments above and the following remarks. Claims 1-21 were pending and at issue in this application prior to this amendment. By this amendment, Claims 1 and 14 have been amended. No new matter has been added.

### **I. OBVIOUSNESS-TYPE DOUBLE PATENTING**

In the Office Action claims 1-21 were rejected on the ground of non-statutory obviousness-type double patenting over claims 1-11 of commonly-owned U.S. Patent No. 6,635,069 and claims 1-12 of commonly-owned U.S. Patent No. 6,929,654. Applicant hereby submits a terminal disclaimer under 37 C.F.R. 1.321(c), disclaiming the terminal portion of any patent granted on the present patent application which would extend beyond the expiration date of the full term of U.S. Patent No. 6,635,069 or U.S. Patent No. 6,929,654.

Applicant notes that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991). The filing of a terminal disclaimer simply serves the administrative function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.

### **II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102 OVER SCHAEFER ET AL.**

Claims 1-21 stand rejected under 35 U.S.C. 102(b) as being anticipated by Schaefer et al. (U.S. Patent No. 7,029,486). In order to anticipate a claim under § 102(b), a single prior art reference must disclose, either expressly or inherently, each and every limitation of the claimed

invention. Applicant respectfully submits that this rejection should be withdrawn because Schaefer et al. does not disclose, either expressly or inherently, Applicant's claimed invention as amended herein. Applicant has amended claim 1 to require that the vaso-occlusive coil have a three-dimensional secondary shape having a second section comprising non-overlapping loops, in which the non-overlapping loops comprises a section of the coil in which the primary helical coil is unwound. All of the so-called loops shown and described in Schaefer et al. are comprised of the primary helical coil shaped wire in its completely wound configuration.

Claim 1, as amended herein, is directed to a vaso-occlusive coil having an elongate helical primary shape defining a primary axis. In one described embodiment, this helical primary shape is then formed into a three-dimensional secondary shape. The three-dimensional secondary shape may be formed by winding the primary shape over a mandrel, and then heat-treating the device. The secondary shape comprises a first section which is also in a helical form. However, a second section of the secondary shape is formed into a plurality of non-overlapping loops. The non-overlapping loops are specifically formed in order to provide certain desirable folding characteristics, and also certain advantageous mechanical properties. In addition, the successive loops of the non-overlapping loops lie in planes oriented at an angle between about 30 degrees and 150 degrees.

In contrast to Applicant's claimed invention, ALL of the coils disclosed in Schaefer et al. are formed entirely of a helical coil, including the portions that define loops. This is very distinct from Applicant's invention in which a second section of the secondary shape is intentionally not shaped in a helical form. Thus, Schaefer et al. does not actually include any section in which the elongate wire comprising the coil is not in a helical shape. The larger loops shown in Figs. 8-9 and 12-17 of Schaefer et al. are formed from the helical coiled wire. In marked contrast, the non-overlapping

loops of Applicants' invention are formed by uncoiling the helical coil of the primary shape into the loops of the secondary shape.

Claims 1 and 14 have been amended herein to clarify that the non-overlapping loops formed from a section of the coil in which the primary helical coil is unwound. Thus, claims 1 and 14 patentable distinguish over Schaefer et al. Moreover, claims 2-13 and 15-21 depend from claims 1 or 14, or an intervening claim, and are not anticipated by Schaefer et al. for at least the same reasons as claims 1 and 14.

### **CONCLUSION**

Any claim amendments which are not specifically discussed in the above remarks are not made for reasons of patentability, do not affect the scope of the claims, and it is respectfully submitted that the claims satisfy the statutory requirements for patentability without the entry of such amendments. These amendments have only been made to increase claim readability, to improve grammar, or to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.

In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the Examiner's rejections have been overcome. Accordingly, allowance is earnestly solicited. If the Examiner feels that a telephone interview could expedite resolution of any remaining issues, the examiner is encouraged to contact Applicant's undersigned representative at the phone number listed below.

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Respectfully submitted,  
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Dated: May 12, 2007

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